

REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks. Claims 12 and 13 are under consideration. With the above amendments, claims 12 and 13 have been amended to more particularly point out certain embodiments of Applicants' invention. It is urged that support for all the above amendments may be found throughout the specification as originally filed and that none of the amendments constitutes new matter. It should also be noted that the above amendments are not to be construed as acquiescence with regard to the Examiner's rejections and are made without prejudice to prosecution of any subject matter removed or modified by this amendment in a related divisional, continuation, or continuation-in-part application.

Rejections under 35 U.S.C. §§ 101 and 112, first paragraph (Utility/Enablement)

Claims 12 and 13 stand rejected under 35 U.S.C. § 101 as allegedly lacking patentable utility. The claims also stand rejected under 35 U.S.C. § 112, first paragraph as lacking enablement. The Action asserts that the invention is allegedly not supported by either a credible, specific, or substantial utility or a well-established utility. Specifically, the Action alleges that the invention lacks utility due to an alleged lack of disclosure of the identity and function of the protein set forth in SEQ ID NO:1789. The Action further contends that a method lacks substantial utility when the starting material of the method itself has no specific utility. Finally, the Action asserts that, due to the alleged lack of utility, the skilled artisan would not know how to make and use the invention.

Applicants respectfully traverse this rejection on the following grounds.

The specification as filed clearly describes that the claimed polynucleotide of SEQ ID NO:1788 is overexpressed in colon tumor samples as compared to normal colon and a panel of other normal tissues (see for example, Table 2, page 138, clone identifier R0683G3, and page 141, lines 19-24). Thus, based on the tumor-associated expression profile of C1491, this colon tumor antigen may be used, for example, for immunotherapeutic purposes in individuals with colon cancer and/or as a diagnostic marker for colon cancer. In view of the expression

pattern of the polynucleotide encoding the protein, the skilled artisan would readily recognize that the polynucleotide can be used, for example, in any number of diagnostic settings. Further, the skilled artisan would readily appreciate that there is a reasonable expectation that the protein encoded by the polynucleotide would also be overexpressed in colon tumor tissue as compared to normal tissues. Therefore, the protein encoded by this polynucleotide has any number of utilities, for example as a diagnostic tool for detecting or generating antibodies specific for C1491P. Thus, Applicants submit that the starting material, *e.g.* the protein set forth in SEQ ID NO:1789, does have a specific, substantial, and credible utility or, a well-established utility.

With regard to the Action's assertion that the invention lacks utility due to an alleged lack of disclosure of the identity and function of the protein set forth in SEQ ID NO:1789, Applicants respectfully submit that the identity and biological function of C1491P is irrelevant for its use in any number of applications, for example as a diagnostic tool for colon cancer. Rather, as would be readily appreciated by the skilled artisan, it is the above-noted colon-tumor associated expression profile described in the specification as filed, which is pertinent to its utility. Regardless of the biological function of C1491P, the colon-tumor associated expression profile of this antigen permits its use, for example, as a diagnostic marker for colon cancer.

In view of the above remarks, Applicants urge that the claimed invention has a specific, substantial, and credible utility or, a well-established utility and respectfully submit that the above rejections of claims 12 and 13 under 35 U.S.C. §§ 101 and 112, first paragraph may be properly withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph (Written Description)

Claims 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking written description. Specifically, the Action asserts that the specification allegedly provides insufficient written description to support the genus encompassed by the claimed sequences having at least 90% identity to the sequence set forth in SEQ ID NO:1789.

Without acquiescing to the Action's rejection, Applicants have amended claims 12 and 13 without prejudice, to remove recitation of sequences having at least 90% identity to

the sequence set forth in SEQ ID NO:1789. Thus, Applicants submit that the rejection of the claims under 35 U.S.C. § 112, first paragraph as allegedly lacking written description has been obviated and may be properly withdrawn.

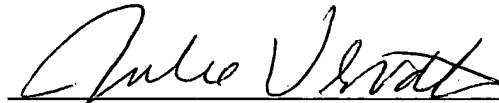
The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Applicants respectfully submit that all the claims remaining in the application are now allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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